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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,068	10/30/2003	Brian Burkinshaw	2108.000400/IOI-444-CIP	8117
45488	7590	11/29/2004	EXAMINER	
WILLIAMS, MORGAN & AMERSON, P.C./ZIMMER 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			BONDERER, DAVID A	
		ART UNIT	PAPER NUMBER	
		3732		

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,068	BURKINSHAW ET AL.	
	Examiner	Art Unit	
	D. Austin Bonderer	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 April 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-59 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-11, 13-26, 28, 31-38, 40-46, 48 and 50-59 is/are rejected.

7) Claim(s) 12, 27, 29, 30, 39, 47 and 49 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 10, 13-19, 24, 25, 28, 31, 32, 37, 40, 41, 43, 46, 48, 51-55, and 57-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Chanet et al.

Chanet discloses a device for tattooing comprising:

- Pins;
- A trigger 20;
- Pins are operatively coupled to said housing;
- Biasing member/ diaphragm 9;
- A pneumatic drive with a cylinder 30;
- A rod 31;
- A housing 3;
- Disposable pins (capable of being discarded);
- The actuation is limited by the diaphragm;
- A hammer 8 with a striking face;
- A striking head of pins (base of the pins);
- A recess in the hammer for insertion of a structural member (the rod);

- The hammer hits a plate 8';

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 1964 (1987). The use in subchondral bone is considered to be intended use.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 7, 9, 11, 18, 20-23, 26, 30, 33-36, 38, 42, 44, 4550, 56, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chanet.

Chanet discloses a hammer that is not pivotally actuated, or that directly connects with the base of the pins. It would have been an obvious matter of design choice to have modified Chanet with a pivoting hammer an where the hammer directly hits the base of the pins, since applicant has not disclosed that having the pivoting hammer or having the pin hit by the hammer solves any stated problem or is for any particular purpose and it appears that Chanet would perform equally well.

It is not disclosed how the pneumatic actuation works with Chanet. However, the use of an air block associated with the trigger is obvious to one of ordinary skill in the art.

It is not shown if the trigger is biased, however it is obvious to one of ordinary skill in the art to use a biasing member in order to use the trigger more than once.

5. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chanet in view of Buttner.

Chanent lacks the specific disclosure of a biasing member for the hammer. Buttner teaches the use of a spring. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a spring as taught by Buttner in order to return the hammer to its original position.

Allowable Subject Matter

6. Claims 12, 27, 29, 30, 39, 47, 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38 recites the limitation "said structural member" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Examiners note

9. Claims 54 appears to invoke 112 6th. Please indicate if this is your intention. However, the claims have not been examined as such.

The applicant must look to the dependent claims of 54 for they are dependent from an independent claim that invokes USC 112 6th paragraph. When the dependent claims add structure to the "means" they lose the status under 112 6th and become a broader claim than the one from which it depends.

An objection to these claims will be presented in the next office action if 112 6th is invoked.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Park, Becker et al., and Bates et al. disclose relevant art to the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Austin Bonderer whose telephone number is 571.272.4708. The examiner can normally be reached on Monday- Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571.272.4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dab


PEDRO PHILOGENE
PRIMARY EXAMINER